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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,693	10/03/2003	William J. Murphy	JJK-0329 (P2002J099)	9950

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NEW YORK, NY 10022

EXAMINER
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NGUYEN, TAM M

ART UNIT	PAPER NUMBER
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1764

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/678,693

**Applicant(s)**

MURPHY ET AL.

**Examiner**

Tam M. Nguyen

**Art Unit**

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15-18 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al. (5,951,848) in view of Kresge et al. (5,837,639) and either Benazzi et al. (6,884,339) or Carroll et al. (6,517,704).

Baker discloses a process for catalytic dewaxing a feedstock. The feedstock is first passed into a hydrotreating zone to remove nitrogen and sulfur compounds. The hydrogenating zone is operated at a temperature of from 300 to 450° C, at a pressure of from 6900 to 20700 kPa, at a LHSV of from 0.1 to 10 hr<sup>-1</sup>, and at a hydrogen rate of from 200 to 800 SCF/Bbl (900 to 1800 m<sup>3</sup>/m<sup>3</sup>). The hydrotreating catalyst comprises nickel and tungsten. The effluent from the hydrotreating zone is entirely passed into a dewaxing zone containing a dewaxing catalyst including ZSM-48, a metal hydrogenation component (e.g., Pt or Pd). The dewaxing zone is operated at conditions similar to the hydrotreating zone. The product from the dewaxing zone is further treated in a hydrofinishing zone. (See col. 1, lines 9-20; col. 2, line 46 through col. 3, line 3; col. 4, line 14 through col. 5, line 29; col. 5, line 62 through col. 6, line 4; col. 8, line 1 through col. 10, line 47)

Baker does not disclose that the feedstock comprises about 7270 to 20,000 ppm of sulfur, does not specifically disclose that the effluent from the dewaxing step is passed into a hydrofinishing zone without disengagement, does not disclose that the hydrofinishing catalyst is MCM-41, and does not disclose that the hydrotreating and the hydrodewaxing are operated in two separated reactors,

Both Benazzi and Carroll disclose a hydroprocessing process wherein an effluent from the dewaxing step is directly passed into a hydrofinishing zone without disengagement. Benazzi further discloses that the pre-hydrotreating and the dewaxing (hydrocracking) can be operated in

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a single reactor or in different reactors. Carroll also discloses that the hydrotreating and the dewaxing are operated in different reactors. (See Benazzi col. 8, lines 36-38; claims 1-4; Carroll col. 5, lines 53-57)

Kresge teaches the use of MCM-41 as a hydrotreating catalyst. (See col. 4, lines 57-68; col. 5, lines 1-16; col. 33, lines 33-37)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Baker by passing an effluent from the dewaxing step directly into a hydrofinishing zone without disengagement because both Benazzi and Carroll teach that it is advantaged to pass the entire dewaxed stream from the dewaxing stage to the hydrofinishing zone.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Baker by using MCM-41 as a hydrofinishing catalyst because Kresge teaches that MCM-41 is a highly effective hydrotreating catalyst.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Baker by operating the hydrotreating and dewaxing steps in different reactor as taught by either Benazzi or Carroll because it would be expected that the results would be the same or similar when operating the hydrotreating step and the dewaxing step in either a single reactor or in different reactor because in both cases the hydrocarbon feeds are contacted with catalysts and hydrogen.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Baker by using a feedstock comprising at

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least 7270 ppm of sulfur as claimed because Baker teaches that a feedstock comprises a moderate level of sulfur can be used in the process (see col. 7, lines 52-56). It would be expected that a feed comprising about 7270 ppm of sulfur would be successfully treated in the process of Baker.

Claims 20-23 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao et al. (6,264,826) in view of Kresge et al. (5,837,639) and either Benazzi et al. (6,884,339) or Carroll et al. (6,517,704).

Xiao discloses a process for preparing lubricating base oils from a sulfur containing feedstock. The feedstock is derived from a solvent extracting process wherein foots oils is prepared by separating oil from the wax. The foot oils, which comprises about 0.5 to 2.5 wt.% (5000 to 25,000 ppm) of sulfur compounds and about 50 to 2000 ppm of nitrogen compounds, is fed into a hydrotreating zone wherein nitrogen and sulfur compounds are removed. The hydrotreating zone is operated at a temperature of from 260 to 427° C, at a pressure of from less than 11 Mpa, at LHSV of about 0.5, and at hydrogen rate of about 722 m<sup>3</sup>/m<sup>3</sup>. The entire effluent from the hydrotreating zone is then fed into a dewaxing zone containing a dewaxing catalyst including ZSM-5 and SAPO-11, a metal hydrogenation component (e.g., Pt or Pd). The dewaxing process is operated at temperature of from 400 to 900° F, at a pressure of from .45 to 20.8 Mpa, at LHSV of from about 0.1 to 5 hr<sup>-1</sup>, and at hydrogen gas rates of from 89.1 to 1780 m<sup>3</sup>/m<sup>3</sup>. The product from the dewaxing zone is then passed into a hydrofinishing zone to provide a final product. (See col. 2, line 51 through col. 6, line 59; col. 8, line 53 through col. 10, line 40)

Xiao does not specifically disclose that the effluent from the dewaxing step is passed into a hydrofinishing zone without disengagement and does not disclose that the hydrofinishing catalyst is MCM-41.

Both Benazzi and Carroll disclose a hydroprocessing process wherein an effluent from the dewaxing step is directly passed into a hydrofinishing zone without disengagement. (See Benazzi col. 8, lines 36-38; Carroll col. 5, lines 53-57)

Kresge teaches the use of MCM-41 as a hydrotreating catalyst. (See col. 4, lines 57-68; col. 5, lines 1-16; col. 33, lines 33-37)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Xiao by passing the effluent from the dewaxing step directly into a hydrofinishing zone without disengagement because both Benazzi and Carroll teach that it is advantaged to pass the entire dewaxed stream from the dewaxing stage to the hydrofinishing zone.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Xiao by using MCM-41 as a hydrofinishing catalyst because Kresge teaches that MCM-41 is a highly effective hydrotreating catalyst.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over references as applied to claims 20-23 above, and further in view of Cody et al. (5,935,417).

Xiao does not specifically disclose a step of blending a raffinate feedstock and at least one of a slack wax or foots oil.

Cody discloses a step of blending a raffinate feedstock with foots oil to form a blended feedstock. (See col. 5, lines 9-15)

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Xiao by using the blend feedstock of Cody because any waxy feedstock can be used in the process of Xiao. Therefore, it would be expected that the blend feedstock would be successfully treated in the process of Xiao.

### ***Response to Arguments***

The argument that neither Baker, nor Carroll nor Kresge teaches a feedstock comprising at least 72070 ppm of sulfur is not persuasive. Even though Baker prefers to use a feedstock having about 5000 ppm of sulfur, Baker also teaches that a feed having a moderate level of sulfur can also be used in the process. Therefore, one of skill in the art would use any feed having a sulfur content greater than 5000 ppm including the claimed feed. The test for obviousness is what the teachings and disclosures of the prior art would have suggested to one of ordinary skill in the art, even including unpreferred embodiments. *See In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976).

The argument that neither Benazzi, Kresge, nor Carroll describes ZSM-48 is not persuasive because Xiao already teaches that ZSM-48 can be used in the process.



***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam M. Nguyen whose telephone number is (571) 272-1452. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tam M. Nguyen  
Examiner  
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A handwritten signature in black ink, appearing to read 'Tam', with a horizontal line drawn underneath it.

TN